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10/694,287

10/27/2003

Reiner Rygiel

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EXAMINER

PRITCHETT, JOSHUA L

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINER RYGIEL

Appeal 2009-2059
Application 10/694,287
Technology Center 2800

Decided:¹ April 29, 2009

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-13. Claim 1 is illustrative:

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1. A sample carrier for a confocal microscope, comprising:

a first coverslip and a second coverslip immovably secured in a frame and forming a cavity between them, the second coverslip having a mirror-coated zone and a sample region which are defined on the second coverslip;

a medium uniformly filling in the cavity, the medium having approximately the same refractive index as the first and the second coverslips.

The Examiner relied upon the following references as evidence of obviousness:

Aagard	3,720,924	Mar. 13, 1973
Lanni	4,621,911	Nov. 11, 1986
Eastman	US 6,411,434 B1	Jun. 25, 2002
Lakowicz	US 2002/0160400 A1	Oct. 31, 2002

Appellant's claimed invention is directed to a sample carrier for a confocal microscope. The carrier comprises first and second coverslips that are immovably secured in a frame. The coverslips form a cavity therebetween.

The appealed claims stand rejected under 35 U.S.C. 103(a) as follows:

- (a) Claims 1, 2, 4, 5, and 7-13 over Eastman in view of Lanni,
- (b) Claim 3 over Eastman in view of Lanni and Lakowicz, and
- (c) Claim 6 over Eastman in view of Lanni and Aagard.

We have thoroughly reviewed the respective positions advanced by Appellant and the Examiner. In so doing, we find ourselves in agreement with Appellant that the Examiner has failed to establish a prima facie case of obviousness for the claimed subject. Accordingly, we will not sustain the Examiner's rejections.

The appealed claims require that the first and second coverslips be “immovably secured in a frame”. The Examiner finds that Eastman’s membrane 26 corresponds to the claimed first coverslip whereas reference window 16 corresponds to Appellant’s second coverslip. However, as stressed by Appellant, the pliable membrane of Eastman “is bent to contact window (16) and to be heat bonded or sonic welded to that window (16), as shown in Fig. 9 and described in Col. 8, line 58 - Col. 9, line 1 of Eastman” (page 5 of Brief, last paragraph). As such, we agree with Appellant that it can not be reasonably said that membrane 26 of Eastman meets the claimed requirement for a first coverslip that is immovably secured in a frame. Manifestly, Eastman’s Figs. 6-9 illustrate that membrane 26 is not immovably secured to a frame but, rather, is designed to move and be bonded to window 16.

The Examiner reasons that all materials have a Young’s Modulus and, therefore, Appellant’s “coverslip will inherently have some of ability to flex” (page 7 Ans., last paragraph). However, notwithstanding whether or not Appellant’s coverslip possesses an imperceivable degree of flexibility, the issue is whether the Examiner has demonstrated that Eastman reasonably appears to teach or suggest a coverslip that is immovably secured to a frame. In our view, Eastman’s bendable membrane 26 does not meet the claim requirement at issue.

The “secondary” references cited by the Examiner, Lanni, Lakowicz, and Aagard, do not remedy the deficiency of the Eastman disclosure discussed above.

In conclusion, based on the foregoing, we are constrained to reverse the Examiner’s rejections.

REVERSED

Appeal 2009-2059
Application 10/694,287

PL initial:
sld

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